

REMARKS***Summary of the Amendment***

Upon entry of the above amendment, Applicants will have amended claims 1 and 33. Accordingly, claims 1 – 33 remain pending. However, as the Examiner has withdrawn claims 16 – 32, directed to the non-elected invention, from further consideration, only claims 1 – 15 and 33 are currently under consideration by the Examiner.

Summary of the Official Action

In the instant Final Office Action, the Examiner has rejected claims 1 – 15 and 33 over the art of record. Moreover, claims 16 – 32, directed to the non-elected inventions, remain withdrawn from consideration. By the present amendment and remarks, Applicants submit that the rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Amendment is Proper for Entry and Consideration

Applicants submit that, as the instant amendment does not raise any question of new matter nor any new issues requiring further search by the examiner, the instant amendment is proper for entry and consideration. Moreover, Applicants request that, as the instant amendment places the application in condition for allowance, that upon entry of present amendment, that the application and claims be indicated as allowed.

Traversal of Rejection Under 35 U.S.C. §102(b)

Applicants traverse the rejection of claims 1 – 15 under 35 U.S.C. § 102(b) as being anticipated by WO 01/98585 [hereinafter “WO ‘585”]. The Examiner asserts that WO ‘585 shows all of the features of the instant invention, including a wide nip calender upstream from a coating device. Applicants traverse the Examiner’s assertions.

Applicants initially note that, as the WO document is neither a U.S. Patent nor a published U.S. Patent Application, this document cannot be prior art under 35 U.S.C. § 102(e). However, as the document was published more than one year prior to the U.S. filing of the instant application, Applicants have addressed this rejection under 35 U.S.C. § 102(b).

As previously presented, Applicants note that the instant invention is directed to impregnating paper or cardboard webs with an impregnating agent in order to obtain a web that at least in part acts in a hydrophobic manner. Moreover, web strength is improved. When such agents are applied to thin webs, it is relatively easy to press the agent into or through the web to ensure a consistent application of the agent over the entire cross-section of the web.

However, when thicker webs are utilized, it becomes more difficult to ensure this permeation of the agent into the web, such that the agent remains in areas on the surface. As a result, the web surface may be adequately hydrophobic, but the strength of the web is not adequately improved. While penetration of the agent into the web can be improved by operating under high

pressure when applying the agent, a loss of volume occurs, which leads to a reduction in strength.

Accordingly, the present invention utilizes an elastic compression of the web, such that, the agent is applied to the compressed web so that, when the web expands (or decompresses), the web becomes soaked with the agent, resulting in a deeper penetration of impregnating agent into the web. Thus, the instant invention positions the coating device and wide nip calender in such a manner that the web compression is elastic and the compression is still present when the web enters the coating device. In this manner, the expansion of the web (decompression) draws the impregnating agent into the web. Accordingly, Applicants' independent claim 1, as now amended, recites, *inter alia*, a wide nip calender located, with respect to a web travel direction, before said coating device, said wide nip calender comprising a circulating jacket and a back pressure element arranged to form a wide nip and *an elastic compression of the web*, such that a distance between said coating device and said wide nip calender is such that *the elastic compression of the web by said wide nip calender is still present when the web enters the coating device*. Further, Applicants' independent claim 33, as now amended, recites, *inter alia*, a wide nip calender located, with respect to a web travel direction, before said coating device, said wide nip calender comprising a circulating jacket and a back pressure element arranged to form a wide nip and *an elastic compression of the web*. Applicants submit that WO '585 fails to disclose at least the above-noted features of the invention.

While WO '585 discloses a wide nip calender followed by a coating device, Applicants note that WO '585 expressly discloses that the nip produces a permanent compression, see, e.g., page 9, line 1 and the Abstract, which is wholly inconsistent with expressly recited features of at least independent claims 1 and 33.

Thus, Applicants submit that WO '585 teaches a coating agent intended to act merely on the surface of a permanently compressed web, such that the features of the instant invention are not even arguably disclosed.

Because WO '585 fails to disclose each and every feature of the instant invention, Applicants submit that the Examiner has failed to establish an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(b). Therefore, Applicants submit that the instant rejection is improper and should be withdrawn.

Further, Applicants submit that claims 2 – 15 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicants submit that WO '585 fails to anticipate, *inter alia*, the impregnating agent comprises a starch solution or other coating agents commonly used in paper upgrading, as recited in claim 2; the starch solution comprises a starch size, as recited in claim 3; the web comprises one of a paper or cardboard web, as recited in claim 4; the impregnating agent is applied to a web having a basis weight over 40 g/m², as recited in claim 5; between said wide nip and said coating device, no other web processing devices are provided, as

recited in claim 6; at least one guide device is arranged between said wide nip and said coating device, as recited in claim 7; said wide nip calender further comprises a heating device, as recited in claim 8; said heating device is formed by said back pressure element, as recited in claim 9; said heating device comprises a surface structured to guide the web through said wide nip, and said surface having a temperature adjustable to at least 200°C, as recited in claim 10; said coating device comprises a film press, as recited in claim 11; further comprising a drying area located downstream of said coating device, as recited in claim 12; said wide nip is heated to a temperature higher than a temperature in said drying area, as recited in claim 13; said wide nip is adjustably heated to at least a plasticizing temperature of web fibers of the web, as recited in claim 14; and further comprising a reeling device arranged downstream of said coating device, wherein no glazing device is arranged between said coating device and said reeling device, as recited in claim 15.

Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of claims 1 – 15 and 33 under 35 U.S.C. § 102(b) and indicate that these claims are allowable.

Application is Allowable

Thus, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

Authorization to Charge Deposit Account

The undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

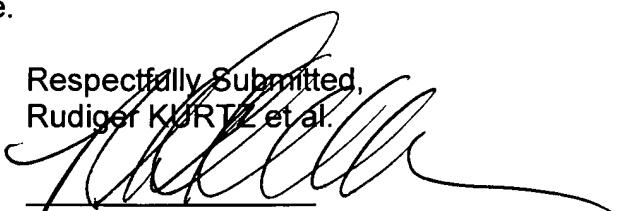
CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicants' invention, as recited in each of claims 1 – 15 and 33. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully Submitted,
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